

REMARKS

The Applicant has fully considered the Official Action dated June 4, 2003, and has amended the application in response thereto. Claims 1 and 16 were amended in response to the rejections under 35 USC §102. Claim 15 was amended to correct an obvious grammatical error. Claims 5 and 18 – 20 are withdrawn from consideration pending allowance of a generic claims 1 and 16. Claims 1 – 20 remain in the application and claims 1-4 and 6 – 17 remain for consideration. The Applicant believes, for the reasons stated below, that all claims are in condition for allowance and therefore respectfully requests that claims 1 - 20 be allowed.

The following remarks will follow the order set forth in the Official Action:

I. Election/Restriction

The Applicant affirms the election of species 1, claims 1-4 and 6 – 17, without traverse, and the corresponding withdrawal of claims 5 and 18 – 20 from consideration.

II. Response to Claim Objections

Claim 15 was objected to as depending from a later claim. It is currently amended to conform to Applicant's original intent: to depend from claim 1. This amendment is fully supported by the specification. The Applicant extends his thanks to the Examiner for pointing out this error and believes that this amendment overcomes the objection made in the Official Action.

III. Response to 102(b) rejection based upon United States Patent No. 197,595

Claims 1, 7-9, 11, and 12 stand rejected under 35 U.S.C. 102(b) as anticipated by United States Patent No. 197,595 (hereafter "Brown"), which purports to disclose a convertible goods box. Specifically, Figures 1 and 4 were cited as anticipating the present invention. For the following reasons, the Applicant respectfully disagrees.

In order for a prior art reference to anticipate a claimed invention, it must include each and every element and limitation of the claim. The Applicant asserts that Brown does not disclose a lid having a bottom surface that comprises at least one compartment disposed therein and, therefore, Brown cannot anticipate the invention claimed in claims 1 and 16.

Brown discloses a convertible goods box that is used to hold collars and cuffs, and for use as a “cigar-case and match box” after the collars and cuffs have been sold. “The removable lid of the box consists of the plate or disc C having a neck or handle, c, which is hollow, forming a box for matches, and provided with a lid or stopper, c’.” (*Brown, pg.1, col. 1, last paragraph*). The lid is adapted for removal and reversal. When arranged as shown in Fig. 1 of the Brown patent, the “appearance is such as to make it an attractive ornament”. Likewise, the lid may be turned over an arranged as shown in FIG. 1, such that “the box is reduced in bulk for shipping purposes”. Accordingly, when arranged in a display position, the **top surface** of the removable lid of Brown includes a compartment. Conversely, the Applicant’s claimed lid has its compartment in the bottom surface thereof.

Similarly, no mention is made of the size of the compartment of Brown, other than to say that it is sized to accommodate matches. Thus, Brown fails to teach or suggest the claimed limitation that the compartment be “dimensioned to allow a single candle to be displayed therein”.

As Brown does not disclose a lid having a compartment in its bottom surface that is dimensioned to allow a single candle to be displayed therein, the Applicant asserts that Brown cannot anticipate claims 1 and 16. Accordingly, the Applicant respectfully requests that this rejection be reconsidered and withdrawn.

Although claims 1 and 16 were not specifically rejected as obvious under 35 USC §103, the Applicant likewise asserts that it would not be obvious to modify the design of Brown to include the claimed lid “wherein said bottom surface of said lid comprises at least one compartment disposed therein, said compartment being dimensioned to allow a single candle to be displayed therein”.

MPEP §2142 states that “(t)o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claim limitations.” The Applicant asserts that these three obviousness requirements are not met.

First, as noted above, Brown does not disclose a lid having a compartment in its bottom surface that is dimensioned to allow a single candle to be displayed therein. Further, as explained below in connection with the rejections based upon Shultz, such an arrangement is not taught by any of the other cited references. Therefore, the lid of Brown fails to disclose or suggest each of the claimed limitation.

Second, even if it the lid of Brown were found to include a lid having a compartment with the claimed dimensional limitation, the Applicant asserts that there would be no motivation to modify Brown to dispose the compartment in the bottom surface of the lid. As noted above, Brown discloses a container for holding collars and cuffs, and for use as a “cigar-case and match box” after the collars and cuffs have been sold. No mention is made of the storage or display of candles and, in fact, the “compartment” of Brown is an optional feature that is disclosed solely in connection with

the storage of matches (*See Brown, page 1, col. 2, para. 6*; “It is not necessary, in carrying out my invention, that there should be a match-box combined with the cigar-case; but I prefer that one should be combined therewith, as herein shown, as the convenience of the invention as a cigar-case is materially increased by its addition.”) Further, the removable lid of Brown is intended to be reversible only for the purpose of ease of shipping and not for any other purpose. Therefore, there is no explicit suggestion to so modify the Brown reference to include a compartment in its bottom surface for the display of candles.

Finally, were Brown so modified to move the compartment from the top surface to the bottom surface of the lid, the disclosed utility of the compartment as a “match box” would be greatly diminished. By placing the compartment in the bottom surface of the lid, it is inevitable that the cork disclosed by Brown will dislodge and cause the matches to fall from the compartment, requiring removal of the cigars so that the matches may be collected and removed from the base portion of the box. Accordingly, such a modification would have little chance of success in achieving the disclosed purpose of the Brown invention.

For the reasons set forth above, the Applicant asserts that claims 1 and 16 are neither anticipated by, nor obvious in light of, Brown. Further, insofar as claims 2 – 20 depend from novel and unobvious claims, it is likewise asserted that these dependent claims are novel and unobvious in light of Brown, both alone and in combination with the other cited references.

III. Response to 102(b) rejection based upon United States Patent No. 5,879,151

Claims 1,2,4,6, 8-10, 15, and 16 stand rejected under 35 U.S.C. 102(b) as anticipated by Schultz's United States Patent No. 5,879,151, which purports to disclose a 'Votive Candle Holder Lid'. Specifically, figure 4 was cited as anticipating the present invention's claims 1 and 16, et al. The Applicant respectfully disagrees with this rejection.

Shultz discloses a votive candle holder lid and candle package, and method of packaging a candle, that are intended to allow both a votive candle and candle holder to be combined together and sold as a single product. In this invention, the lid is intended to hold the candle in place within the holder during production and to prevent scuffing of the wax due to "jostling" of the package during shipping and storage. In addition, the preferred lid includes holes disposed therethrough, which prevent the color and fragrance of the candle from being. *See generally, Shultz, col. 1, lines 15 – 67.* As illustrated in Figure 4 of Shultz, the lid includes an annular flange (45) that has a rounded at its top surface and has an inner surface dimensioned to mate with the lip (12) of the holder.

In the Official Action, it is asserted that "Schultz discloses . . . a lid having a top surface and a bottom surface . . . , each dimensioned to rest upon the side portion (as shown, Figure 4)". However, the Applicant asserts that this is not the case. Rather, the only described surface of Schultz's lid includes a "flange 45 . . . shaped to match the lip 12 of the holder." *Schultz, col. 3, lines 14-15.* The inventive concept of this design is gripping:

Because the outer wall 54 is tapered, the projection 50 has a smaller outer diameter at its tip 50t. Therefore, even if the lid 10 and holder 20 are slightly askew, the projection 50 will fit into the mouth 1m of the holder 10. As the lid 20 is moved into place, the tapered outer wall 54 will abut the inside of the holder 10, serving as a self-centering mechanism.

Id. at col. 3, lines 61-67. The focus of Schultz's lid is not reversibility. Close examination of FIG. 4 reveals that Schultz's lid cannot be reversed; the lid only fits onto the container one way. This is further evidenced by the fact that the top surface of the lid of Shultz is curved proximate to the flange (45), preventing affirmative alignment with the lip (12) of the holder, and causing it to slip off of the holder. Therefore, it is asserted that the lid of Shultz does not include all of the limitations claimed by the Applicant in claims 1 and 16 and, therefore, cannot anticipate claims 1 and 16.

As was the case with the Brown reference above, it is likewise asserted that claims 1 and 16 are not obvious in light of Shultz. As noted above, Shultz is intended as a means for storing votive candles in their holder such that they are not damaged. In this capacity, the holder is the place in which the candles are burned; *See Fig. 6*. Thus, as the disclosed place for burning is the holder, and as the lid is intended only for use during storage, there would be no motivation to modify the lid of Shultz to allow the top surface to rest on top of the side walls of the holder. Further, there is no disclosure or suggestion in any of the cited references that the lid of a candle holder be used to hold and display a candle.

For the reasons set forth above, the Applicant asserts that claims 1 and 16 are novel and unobvious in light of Shultz, both alone and in combination with the other cited references. Further, insofar as claims 2 – 20 depend from novel and unobvious claims, it is likewise asserted that these dependent claims are novel and unobvious. Therefore, the Applicant respectfully request that the Examiner reconsider and withdraw these rejections.

IV. Response to 103 Rejections

Claims 3, 10, 13, 14 and 17 were each rejected as obvious. However, given the Applicant's assertions that claims 1 and 16 are novel and unobvious, and the fact the these claims each depend from claims 1 and 16, the Applicant asserts that these claims are likewise unobvious.

V. Conclusion

It is felt that a full and complete response has been made to the Official Action and, as such, places all claims in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone Applicant's attorney.

Respectfully submitted,



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